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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,132	03/30/2006	Wilhelmus Christianus Maria Lohbeck	TS6315US	7891

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SHELL OIL COMPANY
P O BOX 2463
HOUSTON, TX 772522463

EXAMINER	
KEE, FANNIE C	
ART UNIT	PAPER NUMBER
3679	
MAIL DATE	DELIVERY MODE
04/27/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/574,132	LOHBECK, WILHELMUS CHRISTIANUS MARIA	
	Examiner	Art Unit	
	Fannie Kee	3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 June 2009* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flexible layer of sealing material arranged around the outer tubular element must be shown or the feature canceled from claim 11. No new matter should be entered.

2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 4 is objected to because of the following informalities: replace the word "portions" after the word "second" with --portion-- in line 2.

Correction is required.

4. Claim 5 is objected to because of the following informalities: replace the word "claims: with --claim-- in line 1.

Correction is required.

5. Claim 8 is objected to because of the following informalities: replace the word "portions" after the word "second" with --portion-- in line 2; and, delete the word "the" before the words "respective end portions" in line 2.

Correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5, 8, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Bosma et al WIPO International Application No. WO 03/008760 A1.

With regard to claim 1, and as seen in Figures 3A and 3B, Bosma et al disclose an assembly for use in a wellbore formed in an earth formation, comprising:

an expandable tubular element (6) and an outer structure (64, 60, 17) having first and second portions (64, 17) arranged at a distance from each other;

the first portion and the second portion being restrained to the tubular element throughout expansion such that the distance between the first and second portions changes as a result of radial expansion of the tubular element;

the outer structure further having a third portion (60) arranged to move radially outward upon the change in distance between the first and second portions;

wherein the radially outward movement of the third portion is larger than the radially outward movement of the tubular element as a result of radial expansion of the tubular element;

wherein the tubular element is susceptible of axial shortening upon radial expansion thereof; and

wherein the first portion and the second portion of the outer structure are connected to the tubular element at respective locations axially spaced from each other.

With regard to claim 2, and as seen in Figures 3A and 3B, Bosma et al disclose the third portion (60) being arranged to move radially outward as a result of a decrease in distance between the first portion and the second portions.

With regard to claim 3, and as seen in Figures 3A and 3B, Bosma et al disclose the third portion (60) being arranged to move radially outward by virtue of radially outward bending of the third portion.

With regard to claim 5, and as seen in Figures 3A and 3B, Bosma et al disclose the tubular element (6) being an inner tubular element and the outer structure (64, 60, 17) being an outer expandable tubular element arranged around the inner tubular element, and wherein the outer tubular element, when unrestrained from the inner tubular element, is susceptible to less axial shortening as a result of radial expansion than the inner tubular element.

With regard to claim 8, and as seen in Figures 3A and 3B, Bosma et al disclose the first portion (64) and the second portions (17) being the respective end portions of the outer tubular element.

With regard to claim 12, and as seen in Figures 3A and 3B, Bosma et al disclose the outer structure (64, 60, 17) including at least one elongate member (60) extending in the axial direction of the tubular element.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 4, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma et al.

With regard to claim 4, Bosma et al disclose the claimed invention but do not disclose that the first portion and the second portion of the outer structure are welded to the tubular element at respective locations axially spaced from each other. It is well known in the art to use welding as a method to either permanently or semi-permanently attach one element to another element to ensure that the two elements are secured together against accidental dislodging.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have welded the first and second portions of the outer structure to the tubular element at respective locations axially spaced from each other because it is well known in the art to use welding as a method to either permanently or semi-permanently attach one element to

another element to ensure that the two elements are secured together against accidental dislodging.

With regard to claim 13, Bosma et al disclose the claimed invention but do not disclose that the outer structure includes a plurality of said elongate members regularly spaced along the circumference of the tubular element.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the outer structure include a plurality of said elongate members regularly spaced along the circumference of the tubular element instead of just one elongate member so that in the event of failure of one member, the other members are still there to bolster and provide a secure wall for the tubular element.

With regard to claim 14, Bosma et al disclose the claimed invention but do not disclose each said elongate member being a metal bar.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed each said elongate member as a metal bar because a change in the shape of a prior art device is a design consideration within the level of skill of one skilled in the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

10. Claims 6, 7, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma et al in view of Gill et al WIPO International Application No. WO 96/22452.

With regard to claim 6, Bosma et al disclose the claimed invention but do not disclose that the outer tubular element is provided with a plurality of openings in the wall thereof, said openings overlapping each other in the axial direction. Gill et al teach that the wall of the outer tubular element can have a plurality of openings (12) which overlap each other in the axial direction (as seen in Figure 1 - the axial direction being defined as the direction of flow entering the system) to allow for a larger radial expansion of that wall (page 3, lines 25-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the wall of the outer tubular element with a plurality of openings which overlap each other in the axial direction to allow for a larger radial expansion of that wall as taught by Gill et al.

With regard to claim 7, Bosma et al disclose the claimed invention but do not disclose that said openings are slots provided in the wall of the outer expandable tubular element, the slots extending substantially in the axial direction. Gill et al teach that the wall of the outer tubular element can have a plurality of openings (12) which are slots and which extend substantially in the axial direction (the axial direction being defined as the direction of flow entering the system) to allow for a larger radial expansion of that wall (page 3, lines 25-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the openings provided in the wall of the outer tubular element be slots which extend substantially in the axial direction to allow for a larger radial expansion of that wall as taught by Gill et al.

With regard to claim 9, Bosma et al disclose an annular space being formed between the inner tubular element and the outer element upon radial expansion of the inner tubular element but do not disclose that the annular space is filled with a fluidic compound. Gill et al teach that the annular space between the inner tubular element and the outer element can be filled with a fluidic compound to fill and close the openings to increase the compressive strength (page 3, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have filled the annular space with a fluidic compound to fill and close the openings to increase the compressive strength as taught by Gill et al.

With regard to claim 10, Bosma et al disclose the claimed invention but do not disclose that the space is filled with a hardenable fluidic compound. Gill et al teach that the space can be filled with a hardenable fluidic compound to increase the compressive strength (page 3, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have filled the annular space with a hardenable fluidic compound to fill and close the openings to increase the compressive strength as taught by Gill et al.

With regard to claim 11, Bosma et al in view of Gill et al disclose a flexible layer of sealing material (10, 12, 14) being arranged around the outer tubular element.

Response to Arguments

11. Applicant's arguments filed 6/12/09 have been fully considered but they are not persuasive.

a. Applicant argues that Bosma et al do not teach an outer structure having first and second portions that are restrained to the tubular element such that the distance between the first and second portions changes as a result of radial expansion of the tubular element.

Examiner disagrees.

Bosma et al teach first and second portions (64, 17) wherein the distance between these portions changes as a result of radial expansion (see Figures 3A and 3B).

b. Applicant argues that the sleeve 17 (or second portion) is neither a portion of the outer structure nor is it affixed to the tubular element.

As seen in Figures 3A and 3B, second portion 17 is a "portion" of the outer structure and it is "restrained" to the tubular element. Applicant has not claimed that it is "affixed" to the tubular element.

c. Applicant argues that the first portion and the second portion of Bosma et al cannot be the respective end portions of the outer tubular element as these elements are not "connected".

It is not clear why these portions cannot be respective end portions of the outer tubular element because they are not connected. Applicant has not claimed that the outer tubular element is one continuous structure.

d. Applicant argues that there is no evidence that the tubular element of Bosma et al is susceptible to axial shortening upon radial expansion.

As any tubular element which is subjected to radial expansion would normally be susceptible to axial shortening, Bosma et al is susceptible to axial shortening upon radial expansion. It is not clear why Applicant does not feel that Bosma et al would function in the manner of the claimed invention.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fannie Kee whose telephone number is (571) 272-1820. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AARON DUNWOODY/
Primary Examiner, Art Unit 3679

/F. K./
Examiner, Art Unit 3679
April 25, 2010